

REMARKS

Claims 13 to 25 are now pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Claims 13 and 23 were objected to for certain informalities. The claims have been corrected as suggested, and it is therefore respectfully requested that the objections as to claims 13 and 23 be withdrawn.

Claims 23 and 25 were rejected under 35 U.S.C. § 102 as anticipated by Macris, U.S. Patent No. 6,554,232.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

While the rejections may not be agreed with, to facilitate matters, claim 23 has been rewritten to provide the features in which “*a code word memory of the processor unit a list of code words is stored, the identifier being compared with the code word, and wherein with each check of the identifier in the processor unit another code word is used and thus also spent*”.

The Westendorf reference concerns a data transmission method in which first data is transmitted to a first processor, then second data based on the first data is transmitted to a second processor, and a check result is transmitted back to the first processor. As characterized, this permits an independent check of data transmitted to a first processor by a second processor, so that abuse or prohibited use of first data in the first processor can be prevented. (see abstract).

In contrast, claim 23, as presented, provides for increasing the security of the method for transferring at least one data record, since for each checking, another code word -- and thus a new code word -- is used. This means that an old code word -- which has already been used in checking -- is no longer used. Additional advantages of this feature are explained, for example, in the specification, including at page 6, line 25 to page 7, line 5. Thus, for example, claim 23, as presented, has the advantage that a discovery of the required identifier is even impossible by systematic trial and error. (In addition, the advantage should be stressed that the list of code words may be set up individually and by chance for each processor unit.)

Accordingly, the Westendorf reference does not identically describe the claim 23 feature in which “*a code word memory of the processor unit a list of code words is stored, the identifier being compared with the code word, and wherein with each check of the identifier in the processor unit another code word is used and thus also spent*”, as provided for in the context of claim 23, as presented, so that claim 23 is allowable.

Claim 25 depends from claim 23 and is therefore allowable for the same reasons.

Claims 13, 14, 20 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Grawrock, U.S. Patent No. 6,678,833, in view of Westendorf et al., U.S. Published Patent Application No. 2002/00442878.

As to obviousness, in rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third,

the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

While the rejections may not be agreed with, to facilitate matters, claim 13 has been rewritten to include features like those of claim 23, as explained above. Specifically claim 13 now provides *for comparing a code word from a code word memory having a stored list of code words, the code word memory being of the processor unit, and comparing the identifier with the code word, wherein with each check of the identifier in the processor unit another code word is used and therefore no longer available for use.*

Accordingly, claim 13, as presented, is allowable for essentially the same reasons as claim 23, as presented, since the secondary Grawrock reference does not cure – and is not asserted to cure – the critical deficiencies of the primary reference.

Claims 14, 20 and 21 depend from claim 13, as presented, and are therefore allowable for the same reasons as claim 13.

Claims 15 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Grawrock, U.S. Patent No. 6,678,833, in view of Westendorf et al., U.S. Published Patent Application No. 2002/00442878, and in view of Alexander et al., U.S. Patent No. 6,188,602.

Claims 15 and 16 depend from claim 13, as presented, and are therefore allowable for essentially the same reasons as claim 13, since the secondary Grawrock and Alexander references do not cure – and are not asserted to cure – the critical deficiencies of the primary reference.

Claims 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Grawrock, U.S. Patent No. 6,678,833, in view of Westendorf et al., U.S. Published Patent Application No. 2002/00442878, and in view of Jablon et al., U.S. Patent No. 5,421,006.

Claims 17 and 18 depend from claim 13, as presented, and are therefore allowable for essentially the same reasons as claim 13, since the secondary Grawrock and Jablon references do not cure – and are not asserted to cure – the critical deficiencies of the primary reference.

Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Grawrock, U.S. Patent No. 6,678,833, in view of Westendorf et al., U.S. Published Patent Application No. 2002/00442878, and in view of Jablon et al., U.S. Patent No. 5,421,006, and in view of Trang, U.S. Patent No. 5,630,054.

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Claim 19 depends from claim 13, as presented, and is therefore allowable for essentially the same reasons as claim 13, since the secondary Grawrock, Jablon and Trang references do not cure – and are not asserted to cure – the critical deficiencies of the primary reference.

Claim 22 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Grawrock, U.S. Patent No. 6,678,833, in view of Westendorf et al., U.S. Published Patent Application No. 2002/00442878, and in view of Trang, U.S. Patent No. 5,630,054.

Claim 22 depends from claim 13, as presented, and is therefore allowable for essentially the same reasons as claim 13, since the secondary Grawrock and Trang references do not cure – and are not asserted to cure – the critical deficiencies of the primary reference.

Claim 24 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Grawrock, U.S. Patent No. 6,678,833, in view of Trang, U.S. Patent No. 5,630,054, and in view of Osthoff et al., U.S. Published Patent Application No. 2002/00147918.

Claim 24 depends from claim 23, as presented, and is therefore allowable for essentially the same reasons as claim 23, since the secondary Grawrock and Osthoff references do not cure – and are not asserted to cure – the critical deficiencies of the primary reference.

In sum, claims 13 to 25 are allowable.

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Conclusion

In view of the foregoing, it is respectfully submitted that all of presently pending claims 13 to 25 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn. All issues raised by the Examiner have been addressed, so that an early and favorable action on the merits is respectfully requested.

Respectfully submitted,


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